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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,789	06/28/2001	Frank J. Ponzio, Jr.	4640-104	5974

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EXAMINER

OSMAN, RAMY M

ART UNIT PAPER NUMBER

2157

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/894,789

Applicant(s)

PONZIO, JR., FRANK J.

Examiner

Ramy M. Osman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. This communication is responsive to amendment filed on May 23, 2005, where applicant amended claims 37,38,41-44,51-54,57-61,68 and 70. Claims 37-70 are pending.

### *Response to Arguments*

2. Applicant's arguments filed 5/23/2005 have been fully considered but they are not persuasive.
3. Applicant argues that "another digital receiver can independently determine suitability from the marked grade for another subsequent use..." (see Applicants Remarks, bottom of pg 12).

*In reply*, it is noted that the feature upon which applicant relies (i.e., *another* digital receiver) is not recited in the rejected claims. Applicant only mentions a single digital receiver in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant argues that the present invention "would improve the accessing ... because the quality of the data stored would be improved" (see Applicants Remarks, middle of pg 13).

*In reply*, it is noted that the features upon which applicant relies (i.e., *improvement of* data accessing and data storage) are not recited in the rejected claims. Applicant fails to mention 'quality improvement'. Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Applicant argues that “Beal teaches guardrails which are not at all about data quality...” (see Applicants Remarks, top of pg 14).

*In reply*, the guardrails are an indication to the quality of the searched data. Guardrails and attributes represent a quality of the query, and the quality of the data results. The claims are broad and are thus broadly interpreted.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 37-70 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-70 of copending Application No. 09/894,181. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the applications are independent claims 37 and 54, in which the limitation of “assessment means for assessing the quality of the content of

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the preexisting digital data using one or more predefined sets of criteria” is found in the instant application. This is an obvious modification of Application No. 09/894,181 because in order to “assign a grade indicative of the quality of the content...”, a quality must first be assessed and identified. Assessing the quality is an inherent feature that occurs prior to assigning a grade based on quality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Objections*

8. Claims 39 and 56 objected to because of the following informalities: Change “preexisting data” to “preexisting digital data”. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 37-70 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 37 lines 11-12, for example, applicant must outline and make a clear distinction between “preexisting digital data” and “content of preexisting digital data”. There is no discernible difference between ‘data’ and ‘data content’. It is unclear how data can be ‘marked’ without changing or accessing the content of the data. This is because “marking” data inherently involves altering or modifying the data. Therefore the ‘data content’ is also regarded

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as altered or modified. Applicant is requested to outline the difference between “data” and “content of data”.

Applicant is requested to review claims 37-70 in light of the above mention 112 second paragraph rejection, and to resolve the contradictory terminology throughout the claims. The claim language is vague and indefinite and will be broadly interpreted as cited below.

11. Claims 40 and 57 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. It is unclear what is meant by “associating a grade file with (corresponding to) the grade.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 37-70 rejected under 35 U.S.C. 102(e) as being anticipated by Beall et al (US Patent No 6,169,992).**

3. In reference to claims 37 and 54, Beall teaches a method and a system for determining and signaling content quality of digital preexisting digital data, between digital devices including a digital source and a digital receiver, the preexisting digital data having a plurality of data records, each of the plurality of data records having a plurality of data fields, the method comprising:

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assessing the quality of the content of the preexisting digital data using one or more sets of criteria (column 14 lines 5-67, column 37 lines 45-67 and column 38 lines 15-34);

assigning a grade indicative of the quality of the content of the preexisting digital data for at least one of the sets of criteria (column 15 lines 10-22 and column 39 lines 25-40);

marking the preexisting digital data with the assigned grade without changing and without accessing the content of the preexisting digital data (column 14 lines 5-67 and column 38 lines 35-67); and

wherein the receiver dynamically accesses the marked grade to determine suitability for subsequent use of the preexisting digital data without accessing the preexisting digital data (column 37 lines 15-30 & 60-67 and column 38 lines 1-35);

whereby the digital receiver can independently determine suitability from the marked grade for another use of the preexisting digital data without accessing the preexisting digital data (column 4 line 60 – column 5 line 20 and column 14 lines 5-67).

4. In reference to claims 38 and 55, Beall teaches the method and system as recited in claims 37 and 54 wherein the step of linking further comprises associating a portion of a file name corresponding to the grade (column 14 lines 5-67 and column 38 lines 35-67).

5. In reference to claims 39 and 56, Beall teaches the method and system as recited in claims 38 and 55 wherein the filename corresponds to a file containing the preexisting digital data (column 39 lines 1-25).

6. In reference to claims 40 and 57, Beall teaches the method and system as recited in claims 37 and 54 further comprising associating a grade file with the grade (column 39 lines 1-25).

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7. In reference to claims 41 and 58, Beall teaches the method and system as recited in claims 37 and 54 wherein the quality corresponds to a particular data field of the plurality of data fields (column 37 lines 35-67).
8. In reference to claims 42 and 59, Beall teaches the method and system as recited in claims 37 and 54 wherein the quality corresponds to a particular record of the plurality of data records (column 37 lines 35-67).
9. In reference to claims 43 and 60, Beall the method and system as recited in claims 42 and 59 wherein a particular quality corresponds to a particular record of the plurality of data records (column 37 lines 35-67).
10. In reference to claims 44 and 61, Beall teaches the method and system as recited in claims 43 and 60 wherein a particular quality corresponds to a particular field of the plurality of data fields (column 37 lines 35-67).
11. In reference to claims 45 and 62, Beall teaches the method and system as recited in claims 37 and 54 wherein the criteria for determining the quality is a predefined function (column 38 lines 1-40).
12. In reference to claims 46 and 63, Beall teaches the method and system as recited in claims 37 and 54 wherein the criteria for determining the quality uses access to a database(column 38 lines 1-40).
13. In reference to claims 47 and 64, Beall teaches the method and system as recited in claims 37 and 54 wherein the criteria for determining the quality is an externally defined function (column 38 lines 1-40).



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14. In reference to claims 48 and 65, Beall teaches the method and system as recited in claims 37 and 54 wherein the criteria for determining the quality uses access to an independent database (column 38 lines 1-40).

15. In reference to claims 49 and 66, Beall teaches the method and system as recited in claims 37 and 54 wherein the grade is numeric value, color or Boolean (column 38 lines 20-40, column 39 lines 35-50, column 47 lines 10-30 and column 52 lines 40-67).

16. In reference to claims 50 and 67, Beall teaches the method and system as recited in claims 37 and 54 wherein the step of linking further comprises associating the grade to a data set (column 38 lines 1-60).

17. In reference to claims 51 and 68, Beall teaches the method and system as recited in claims 37 and 54 wherein the criteria for determining the quality is customized by the digital receiver (column 14 lines 5-67 and column 38 lines 1-35).

18. In reference to claims 52 and 69, Beall teaches the method and system as recited in claims 37 and 54 further comprising assigning a rating as a function of the grade (column 38 lines 35-67).

19. In reference to claims 53 and 70, Beall teaches the method and system as recited in claims 37 and 54 further wherein a different one of the sets of criteria for determining the quality provides a different grade for the preexisting digital data (column 14 lines 5-67, column 37 lines 45-67 and column 38 lines 35-67).

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO

August 19, 2005

  
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